

REMARKS

Upon entry of the present amendment the claims under consideration are 1-12, 14-35, 40, 43, 46, 54 and 57-59. Amended Claims 1 and 33 refer to an add-on amount by “weight percent of the substrate” (See p. 12 lines 10-13). Both claims recite that the coalesced elastomeric stripes comprise charged electrospun microfibers or droplets (See p. 12 line 18 – p. 13 line 7). Amended Claim 33 recites a fiber denier range for the substrate instead of a specific basis weight (See p. 9 lines 30-32). Claim 13 is canceled hereby. Various other dependent claims have been amended or canceled for consistency with the independent claims under examination. Applicants respectfully request reconsideration of all outstanding rejections. The Office Action of 30 December 2005 will be addressed with reference to the headings and any paragraph numbers therein.

a) Response to Previous Amendment

Per page 2, paragraph 1 of the Office Action the claim designator of Claim 1 has been changed to “Currently Amended” to reflect the present status. The Applicants thank the Examiner for pointing out this clerical error and expediting prosecution.

b) Claim Objection

Claim 13 is objected to as failing to further limit the independent claim from which it depends. Claim 13 has been canceled.

c) Claim Rejection Based On Morman

Per page 4, paragraph 7, of the Office Action, Claims 1, 4-35, 40, 41, 43, 54 and 57-59 stand rejected under §102(b) as anticipated by, or alternatively under §103(a) as obvious over U.S. Patent 5,910,224 (hereinafter “Morman”). Applicants respectfully traverse the rejections.

Morman generally discusses application of a coalescing elastomer (including discontinuous application) to a neckable nonwoven substrate. Morman gives broad range of elastomer application weight *per se* and broad range of neckable substrate weights *per se* (without relating the two).

Morman does not disclose or suggest coalesced elastomeric stripes comprising charged electrospun microfibers or droplets as recited in Claims 1 and 33. The use of charged electrospun microfibers or droplets provides a commercially feasible way of applying and forming the coalesced elastomeric stripes having a longitudinal axis oriented in the direction of substrate extensibility. Morman, in Fig. 7, discloses elastomeric stripes oriented in the direction of substrate extensibility. However, the stripes are formed by applying silicone-rubber to the substrate over spaced-apart tapes, then removing the tapes to leave silicone-rubber stripes. The substrate is then heated in an oven to crosslink the silicone-rubber (Col. 6 lines 50-65). While the disclosed process produces laboratory samples, Applicants' product is tailored for production on a larger commercial scale.

Apparently, Fig. 7 of Morman (relating to Example 3 at Col. 16 lines 50-65) is the only disclosure of elastomeric stripes oriented in a direction of substrate extensibility. While various other processes are disclosed for forming an elastomeric layer, there is no disclosure employing charged electrospun microfibers or droplets (See Col. 6 lines 56-63). Accordingly, the independent Claims 1 and 33 are not anticipated or rendered obvious by Morman.

Furthermore, Morman does not discuss surface area coverage, add on amounts as a weight percentage of the composite, modulus of elasticity for the substrate composite, stretch hysteresis or set, fluid permeability of an elastomeric area *per se*, or any combination or correlation of the above, as recited in various dependent claims.

In citing Morman, the Examiner has relied upon routine skill in the art where the general conditions of a claim are disclosed in the prior art, lack of criticality/altering a result effective variable, a presumption of inherency, and claimed property values being merely the result of the product disclosed by Morman. As discussed above, the present claims are not anticipated by Morman. Moreover, the Examiner has not presented an analogous teaching from the art or a proper analysis as to why such teaching will make the claimed invention obvious from the understanding of the person of ordinary skill in the art.

It is instructive to look at the authority the Office Action has cited for the proposition that the claims are merely limited to "result effective variables." From *In re Boesch and Slaney*, 205 USPQ 215, 219 (CCPA, 1980):

In the above-quoted passage from [the prior art] we note that lowering the Nv value of a Co-Cr-Ni alloy and deletion of the metals not consumed in precipitation from the Nv calculation are expressly suggested. Considering also, that the composition requirements of the claims and the cited references overlap, we agree with the Solicitor that the prior art would have suggested ..." [emphasis added]

In essence then, the "result effective variables" in *In re Boesch* were identified by the prior art (and not the Examiner). No such express suggestions or equivalent overlapping of the claimed compositions occurs in the present case to support a *prima facie* case of anticipation/obviousness in the present case. Further, the Examiner has ignored the invention as a whole and presumptively identified the "result effective variable" to be elasticity.

There are a multitude of positive effects resulting from the claimed construction(s) which are not limited to the presumptive "result effective variable." Claimed variables such as the amount and type of surface area coverage and add-on amounts by weight percent, affect all of elastic modulus, hysteresis, fluid permeability and economy of the claimed composites. To single out one variable or one factor out of many is to ignore the claimed invention as a whole and impermissibly apply hindsight in using the claims as a laundry list from which to pick and choose pieces of the prior art.

Further with respect to the assertion that Claims 40 and 41 (directed to electrospun fiber and electrospun droplet elastomeric deposition, respectively) have no definable product limitations, it is respectfully urged that the recited forms of deposition will leave a physically identifiable footprint on the product. These forms of deposition are noted in the specification at least at page 2, line 31, to page 3, line 2, to produce an inherently open elastomeric stripe which does not interfere with liquid uptake or vapor transmission.

With respect to Claims 58 and 59, the basis of this rejection represents an unreasonably broad interpretation of the claim language, which clearly and unambiguously states that the stripes themselves are fluid permeable (and not the space between the stripes or some surface layer containing the stripes).

It is therefore respectfully requested that the claim rejection based on Morman be withdrawn.

d) Claim Rejection Based On Desai et al.

Per page 9, paragraph 8, of the Office Action, Claims 1, 4-23, 25-31, 33-35, 43, 46 and 57-59 stand rejected under §102(e) as anticipated by, or alternatively under §103(a) as obvious over U.S. Publication 2003/0088228 (hereinafter “Desai”). Applicants respectfully traverse the rejections.

Generally, Desai does discuss application of a coalescing elastomer (including discontinuous application) to a nonwoven substrate and having an open amount of surface area from 10-80%. Desai gives broad range of elastomer application weight *per se* and broad range of neckable substrate weights *per se* (without relating the two).

Desai does not disclose or suggest coalesced elastomeric stripes comprising charged electrospun microfibers or droplets as recited in Claims 1 and 33. As explained above, the use of charged electrospun fibers or microdroplets provides a commercially feasible way of applying and forming the coalesced elastomeric stripes having a longitudinal axis oriented in the direction of substrate extensibility. This is particularly advantageous where the direction of substrate extensibility is a cross-direction.

Furthermore, Desai does not discuss add on amounts as a weight percentage of the composite, modulus of elasticity for the substrate composite, stretch hysteresis or set, fluid permeability of an elastomeric area *per se*, or any combination or correlation of the above, as required by various dependent claims.

The Examiner has again relied upon routine skill in the art where the general conditions of a claim are disclosed in the prior art, lack of criticality/altering a result effective variable, a presumption of inherency, and claimed property values being merely the result of the product disclosed by Desai. As discussed above, the present claims are not anticipated by Desai. Moreover, the Examiner has not presented an analogous teaching from the art or a proper analysis as to why such teaching will make the claimed invention obvious from the understanding of the person of ordinary skill in the art.

Applicants’ discussion concerning the lack of a *prima facie* case with respect to the Morman reference are equally applicable to the Desai reference and are incorporated and reiterated herein by reference. The same is true with respect to the rejections of claims 58 and 59.

It is therefore respectfully requested that the claim rejection based on Desai be withdrawn.

e) Claim Rejection Based On Morman In View Of Mleziva

Per page 14, paragraph 9, of the Office Action, Claims 2, 3, 40 and 46 stand rejected under §103(a) as obvious over Morman in view of U.S. Patent 6,057,024 (hereinafter “Mleziva”). Applicants respectfully traverse the rejections.

It is the contention of the Examiner that while Morman does not teach any specific width of elastomeric stripes, per Claims 2 and 3, or electrospun fibers with respect to Claim 40, or a 5-50% surface coverage as in Claim 46, but that Mleviza supplies the missing teaching in combination with Morman.

However, Mleziva does not disclose or suggest coalesced elastomeric stripes comprising charged electrospun microfibers or droplets as recited in Claims 1 and 33. The mere disclosure of filaments that are spun does not render them electrospun or charged (Col. 10 lines 43-50). As explained above, Morman also does not suggest this limitation.

Furthermore, Mleziva does not discuss application of a coalescing elastomer (including discontinuous application) to a neckable nonwoven substrate. Mleziva is drawn to a stretchable composite comprising a pre-formed layer of ribbon-shaped elastomeric elements in some embodiments bonded to one or more extensible facing layers such as nonwovens, and in some embodiments, having a layer or web of meltblown elastomeric fibers bonded to the layer of ribbon-shaped elastomeric elements. Therefore, there is no proper suggestion of a combination of Morman and Mleziva from the art itself.

Further, by its inherent structure, Mleziva does not disclose surface area coverage, add on amounts as a weight percentage of the composite, modulus of elasticity for the substrate composite, stretch hysteresis or set, fluid permeability of an elastomeric area *per se*, or any combination or correlation of the above, relating to a substrate with a pattern of untensioned coalesced elastomers within the meaning and reasonable interpretation of the present invention. It is therefore respectfully requested that the present rejections be withdrawn.

f) Conclusion

When viewed as a whole, it is believed that the present invention teaches a novel and non-obvious disposable absorbent article of specifically claimed functionalities which offers advantages not previously seen in the art.

For all the foregoing reasons, the claims as presently amended are believed to be allowable over the art of record. A notice to that effect is earnestly solicited.

g) Request For Telephonic Interview

Applicant intends to be fully responsive to the Office Action. The Examiner is requested to call Applicants' attorney (per the provisions of M.P.E.P. §713) to discuss any concerns of the Office that may remain, in order to expedite the case towards allowance.

Favorable consideration is requested.

Respectfully submitted,



Maxwell J. Petersen
Registration No. 32,772

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60195
TEL (847) 490-1400
FAX (847) 490-1403